No. 95-72

Supreme Court, U.S.
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In The

Supreme Court of the United States

October Term, 1995

LA CIENEGA MUSIC COMPANY,

Petitioner,

vs.

ZZ TOP; BILLY GIBBONS; JOE MICHAEL HILL, p/k/a "DUSTY" HILL; FRANK BEARD; BILL HAM, d/b/a HAMSTEIN MUSIC COMPANY and LONE WOLF PRODUCTION COMPANY; WARNER BROS. RECORDS, INC. and WEA INTERNATIONAL, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

BRIEF IN OPPOSITION FOR RESPONDENTS ZZ TOP, BILLY GIBBONS, JOE MICHAEL HILL, p/k/a "DUSTY" HILL, FRANK BEARD, BILL HAM, d/b/a HAMSTEIN MUSIC COMPANY AND LONE WOLF PRODUCTION COMPANY

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LIST OF PARTIES

The parties to this action are as follows:

The Petitioner (and Plaintiff below) is Bernard Besman, d/b/a La Cienega Music Company.

Respondent ZZ Top is a partnership, and its members are Respondents Billy F. Gibbons, Joe Michael Hill (p/k/a "Dusty" Hill), and Frank Beard.

Respondent Bill Ham is an individual, sued as "d/b/a Hamstein Music Company." Respondent Ham was also erroneously sued as "Lone Wolf Production Company."

Respondents Warner Bros. Records, Inc. and WEA International, Inc. (correctly referred to as Warner Music International) are subsidiaries of a subsidiary of Time Warner, Inc., a corporation which sells shares to the public.

Broadcast Music, Inc. (BMI) was originally a Defendant in this action, but was dismissed by the Plaintiff early in the proceeding by stipulation with the Plaintiff. As a result of the dismissal, BMI was not a party to the Ninth Circuit proceedings. BMI now appears as party to the *amicus* brief.

Glad Music Company was originally a Defendant in this action, but was dismissed by the Plaintiff prior to the Ninth Circuit proceedings.

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SUMMARY OF ARGUMENT AND COUNTERSTATEMENT OF ISSUES PRESENTED

Respondents hereby submit a Summary of the Arguments in Opposition to the Petition for Writ of Certiorari and a Counterstatement of the Issues Presented:

A. The "28-Year Term Issue"

The Petition seeks a Writ of Certiorari from the decision in *La Cienega Music Company v. ZZ Top*, 53 F.3d 950 (9th Cir. 1995), wherein the United States Court of Appeals for the Ninth Circuit affirmed the dismissal of a copyright infringement case on the grounds that if it were assumed that Petitioner had validly subsisting copyrights, they had expired at the end of the initial 28-year copyright term on account of Petitioner's failure to renew.

Accordingly, there is no reason for the Court to review the holding of the Ninth Circuit on the "28-year-term issue," because the judgment of the Court of Appeals is manifestly correct, there is no conflict among the Circuits on this issue, and the decision has little importance beyond the facts of this particular case.

In fact, there is no division of judicial authority on the "28 year term issue" *at all*, and the Petition seeks to mislead the Court by asserting that a conflict among the authorities exists. Therefore, this issue does not meet the criteria for the granting of a Writ of Certiorari under Supreme Court Rule 10.1.

Contrary to the assertions in the Petition, the Second Circuit and the Ninth Circuits are *not* in disagreement on the "28-year term issue." Moreover, all three judges in the Ninth Circuit who decided this case are in agreement on this issue. Even Judge Fernandez, the dissenter in the Ninth Circuit, *concurred* with the majority on the "28-year term issue" ruling.

Moreover, as discussed at length hereinbelow, the Ninth Circuit's ruling on the "28-year term issue" correctly follows and applies this Court's holdings in *Stewart v. Abend*, 495 U.S. 207, 110 S. Ct. 1750 (1990) and *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 80 S. Ct. 792 (1960).

Since there is no division of authority on the "28-year term issue," there is no reason why the Supreme Court should review this aspect of the Ninth Circuit's ruling.

B. The "Divestment Issue"

The United States District Court stated, in its Memorandum of Decision, that release of Petitioner's compositions ("Boogie Chillen" and "Boogie Chillen No. 2") on phonorecords sold to the public in 1948 and 1950 *could have* injected said musical compositions into the public domain under the 1909 Copyright Act, *if* the phonorecords did not include a notice of copyright. The record, however, does not show whether there was a notice of copyright on Petitioner's phonorecords. This advisory ruling by the Courts below is referred to herein as the "divestment issue."

The "divestment issue" *does* involve an apparent split between the Second and Ninth Circuits. The 2-1 majority of the Ninth Circuit panel reiterated the statement by the District Court concerning the "divestment issue," while the *dissenter* would have *reversed* and adopted the Second Circuit rule.

Regardless of this apparent split, certiorari on the "divestment issue" should be denied because it is not yet ripe for decision. The original Motion to Dismiss under Fed. R. Civ. P. 12(b)(6) did not even raise the "divestment issue" due to the fact that it did not appear from the record whether the original phonorecords of "Boogie Chillen" had copyright notices on them

or not.[1] Since this aspect of the rulings of the courts below was *sua sponte*, advisory, and based on hypothetical facts, it is not ripe for decision by this Court. *See generally, Aetna Life Ins. Co. v. Haworth*, 300 U.S. 227, 240-241, 57 S. Ct. 461, 463 (1937).

C. The "Prior Registration Issue"

The Petition and the *amicus* brief *misstate* the holding of the courts below, by asserting that the District Court and the Ninth Circuit held that a phonorecord released under the 1909 Act without *prior registration* of the musical compositions on the phonorecord injected said compositions into the public domain because they were published without registration.[2] Respondents refer to this as the "prior registration issue."

The problem with this supposed "issue" is that the lower Courts made no such ruling. A careful reading discloses that there is no such "prior registration" rule stated in the Ninth Circuit's opinion. Nor could such a holding even be *implied* in the Court of Appeals' opinion. The Ninth Circuit held just the *opposite* when it remanded the "Canned Heat" version of Petitioner's composition to the District Court.

Specifically, the Ninth Circuit's opinion recites that the "Canned Heat" version of "Boogie Chillen" was released on

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1. The District Court's Memorandum of Decision stated: " 'Boogie Chillen' and 'Boogie Chillen No. 2' were published, via the distribution of phonorecords . . . in 1948 and 1950. Thus, unless plaintiff affixed the statutory copyright notice to the phonorecords as required by the 1909 Act, the compositions entered the public domain on these dates. ¶ The complaint does not indicate whether or not plaintiff complied with the requirements of the Act . . . If plaintiff did not comply with the Act, the compositions entered the public domain when the phonorecords were released. . . ."

2. Petition for Writ of Certiorari, Issue No. 2(a).

phonorecord in 1970 but not registered until 1992. 53 F.3d at 952. If the Ninth Circuit had ruled that failure to register before release of a phonorecord constituted a dedication to the public domain, then it would not have remanded because the "Canned Heat" version was registered 22 years late. Instead, it would have declared the "Canned Heat" version in the public domain. Of course, the Ninth Circuit made no such declaration, because it did not hold that a musical copyright was divested if a phonorecord was released prior to registration.

Had the Ninth Circuit desired to create a "prior registration" requirement under the 1909 Act, it would have had to ignore the clear language of the statute. The 1909 Copyright Act, 17 U.S.C. § 13, unambiguously stated that copyright claimants were to "promptly" register "*[a]fter* copyright has been secured by publication of the work with the notice of copyright. . . ."

Based on the clear language of the statute, the District Court, the Petitioners, the *amici*, the Respondents, and the Ninth Circuit all *agree* that registration done "promptly" *after* publication did not inject a work into the public domain. The Ninth Circuit was not asked to rule on the "promptness" issue, and it did not do so. Therefore, this issue should never have been included in the Petition, because there is no decision by the courts below for the Supreme Court to review.

COUNTERSTATEMENT OF THE CASE

This is a copyright infringement suit against the world-famous Texas blues-rock band, "ZZ Top," accusing them of plagiarism in composing the bass line of the hit song "La Grange" — which the band wrote, recorded, and released to the public *20 years ago*. Petitioner acknowledged in his Complaint that "La Grange" has been played on the radio *millions* of times since its 1973 release, that it has had global circulation as a phonorecord,

that it has been recorded by other prominent artists (such as Hank Williams, Jr.), that it has been prominently featured in a national television advertising campaign, and that "La Grange" has been performed at literally thousands of ZZ Top concerts.

Notwithstanding this massive public exposure, the Petitioner alleged that he belatedly "discovered" in 1991 that the bass line of the 1973 song "La Grange" infringed on a "basso ostinato" from "Boogie Chillen," a 1948/1950 composition by John Lee Hooker. The Complaint further alleged that ZZ Top has publicly admitted copying "Boogie Chillen."

The allegations of plagiarism (and Respondents' purported admissions of plagiarism) are disputed. In fact, there are no discernible musical similarities between the 1948 and 1950 versions of "Boogie Chillen" and "La Grange," and Respondents consider the allegation of plagiarism of these works to be frivolous.

Additionally, Respondents dispute the allegation in the Complaint, which asserts that Petitioner Bernard Besman ("Besman") was the *co-author* of "Boogie Chillen." In fact, John Lee Hooker sued Besman in 1981 for, *inter alia*, fraudulently claiming co-authorship of "Boogie Chillen" and other songs. *Hooker v. Bihari*, No. C-81-478-LTL (C.D. 1981). In his 1981 lawsuit, Mr. Hooker claimed he wrote "Boogie Chillen" several years before he met Besman, and Besman was not credited as a composer when Besman signed Hooker and released "Boogie Chillen" in 1948. The 1967 copyright registration of "Boogie Chillen" also listed Hooker as *sole* composer and made no mention of Besman.

Record company executives often falsely claimed co-authorship of songs in the music industry of the 1940s and 1950s, a legal maneuver which allowed them to misappropriate the

actual composer's renewal rights under the 1909 Copyright Act and take all or part of the "songwriter's share" of copyright royalties collected by ASCAP and BMI. Respondents contend that is exactly what Besman did in the case of "Boogie Chillen." However, Besman's lawsuit alleges that Besman *actually* co-wrote the song with John Lee Hooker. Respondents dispute this allegation.

Because of these gross factual misstatements in the Petition (and the underlying Complaint), Respondents respectfully request that the Court take notice that the case comes before it based on the granting of a Motion to Dismiss brought under Fed. R. Civ. P. 12(b)(6), and the "facts" recited by the courts below are based solely on the procedural context of the original motion.[3]

Additionally, the Court should also be aware that the original Rule 12(b)(6) motion was based on one legal ground, and *one ground only*: Petitioner's copyrights *expired* when no renewal was registered and the 28-year term of the copyrights ended in 1976 and 1978.

The only reason this case has attracted so much attention from the music industry is because the District Court also opined that — in the *hypothetical* event that the 1948 and 1950 phonorecords of "Boogie Chillen" and "Boogie Chillen No. 2" did not have copyright notices on them — then they would have been (hypothetically) immediately injected into the public domain in 1948 and 1950, respectively. In fact, the District Court's Memorandum of Decision acknowledges that the record

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3. Petitioner's counsel has issued a joint press release with the attorneys for the *amici*, denouncing the Ninth Circuit's decision. As a result, certain journalists have already been confused by the recital of certain "facts" in the Ninth Circuit's opinion, which fails to delineate between actual facts and mere legal presumptions based on Fed. R. Civ. P. 12(b)(6).

did not disclose whether the 1948 and 1950 phonorecords had copyright notices on them or not.

The United States Court of Appeals for the Ninth Circuit unanimously affirmed on the "28-year term issue," with one member of the panel *concurring* on this aspect of the ruling.

In a 2-1 split, the Ninth Circuit also reiterated the District Court's *advisory opinion,* holding that, *if* "Boogie Chillen" and "Boogie Chillen No. 2" were released on phonorecords without copyright notices, *then* they *would have been* injected into the public domain in 1948 and 1950, respectively.

The Second Circuit follows the opposite rule on the "divestment issue." However, the Second Circuit law is consistent with the "28 year term" ruling in the present matter. Respondents' position is that there is no reason for the Court to grant certiorari on the "28 year term issue" due to the absence of any division of legal authority on this issue.

Since the "divestment" ruling was *hypothetical and advisory* and the "prior registration" issue is *non-existent*, there is no reason for the Court to review this matter at all and certiorari should therefore be denied.

REASONS FOR DENYING THE WRIT

I.

THE DISTRICT COURT PROPERLY DISMISSED BASED ON PETITIONER'S FAILURE TO RENEW THE "BOOGIE CHILLEN" COPYRIGHTS IN 1976 AND 1978.

The *sole basis* for Respondents' original Motion to Dismiss under Fed. R. Civ. P. 12(b)(6) was the expiration of the 28-year

term and the Petitioner's failure to renew the copyright. As noted above, there is *no judicial controversy on this point* because there is not one single judicial opinion contrary to the Ninth Circuit's ruling on the "28-year term issue." The District Court, the majority of the Ninth Circuit, and the concurring opinion in the Ninth Circuit, are *all* in agreement on this issue, and there is *no* decision of the Second Circuit, nor any other Circuit, in conflict.

Petitioner's Complaint expressly alleged "publication" of Petitioner's compositions in 1948 and 1950, and contained no allegation of renewal of the copyrights at the end of the 28-year term.[4] More than 28-years had elapsed since these "publications," so Respondents moved to dismiss based on the absence of an allegation of renewal of the copyrights in the Complaint. Respondents buttressed the motion by requesting Judicial Notice under Fed. R. Evid. 201 of a Certificate from the Copyright Office affirmatively stating that no renewals were on file.

Petitioner did not dispute that no renewals had been filed. Instead, Petitioner sought leave to amend the Complaint, *delete* the aforementioned allegations of "publication" in 1948 and 1950, and *instead* allege that "Boogie Chillen" and "Boogie Chillen No. 2" had been released on phonorecords in 1948 and 1950. The Complaint also alleged that the compositions had not been registered until 1967 and 1970. *Based on such delayed registration, Petitioner asserted, the 28-year terms did not commence until 1967 and 1970.*

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4. The Complaint alleged, at ¶¶ 10 and 12: "In or about 1948, John Lee Hooker and Bernard Besman wrote a musical composition entitled 'Boogie Chillen' . . . [which] was first *published* in or about 1948. . . . ¶ Another version of 'Boogie Chillen' was written by John Lee Hooker and Bernard Besman, entitled 'Boogie Chillen No.2,' which was *published* in or about 1950." (Emphasis added).

Petitioner's theory that the lengthy delay in registering "tolled" the running of the 28-year copyright term was rejected by the District Court, the Ninth Circuit, and even the *concurring* opinion in the Ninth Circuit. That is the exact same theory which Petitioner now presents to this Court.

Significantly, the Complaint also alleged that *one million* phonorecords of "Boogie Chillen" were sold to the public at the time they were initially released. Nonetheless, based on the revisionist version of the Complaint, Petitioner asserted that the 28-year term did not commence running until the tardy *registrations* of the songs in 1967 and 1970.

Under the 1909 Act, the sale of copies to the public was the very essence of a "publication." 17 U.S.C. § 26 (1909). As Professor Nimmer wrote:

> The courts in applying the 1909 Act, were in most instances unpersuaded by the argument that no publication occurs by virtue of the sale of a phonorecord because the record is not a "copy" of the work recorded. On the contrary, the relatively few courts which considered the question were almost unanimous in determining that public sale or other distribution of phonorecords *does* constitute a publication and hence a divestment of common law rights in the works recorded. [citations] This conclusion is certainly consistent with the common understanding of the term "copy." Moreover, it is in accord with the underlying rationale of the publication doctrine. That is, an author in permitting records of his work to be publicly marketed is certainly engaging in a form of

> exploitation of his work and should therefore be required to seek protection, if at all, only under the limited monopoly concept of the federal Copyright Act.[5]

In the annotation to the foregoing section of the text, Professor Nimmer cited, among other cases, *Biltmore Music Corp. v. Kittinger*, 238 F.2d 373 (9th Cir. 1956) (failure to file Notice of Use for release on phonorecord precluded infringement claim); *McIntyre v. Double - A Music Corp.*, 166 F. Supp 681 (S.D. Cal. 1958) (release on phonorecord constituted "publication" under 1909 Copyright Act); *Shapiro, Bernstein & Co. v. Miracle Record Co.*, 91 F. Supp. 473 (N.D. Ill. 1950) (release on phonorecord constituted "publication" under 1909 Copyright Act); *Mills Music, Inc. v. Cromwell Music, Inc.*, 126 F. Supp. 54 (S.D.N.Y. 1954) (manufacture and sale of phonorecords constituted a "publication," divesting common law copyright).

The detailed statutory scheme governing phonorecords in the 1909 Act clearly commenced the running of the 28-year term when a phonorecord was sold to the public in massive quantities. Under the 1909 Act, either registration *or* "publication" commenced the running of the 28-year term.[6] The 1909 Copyright Act not only required that musical compositions be registered "promptly" after publication[7] (which registration by

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5. David Nimmer & Melville B. Nimmer, 1 *Nimmer on Copyright*, § 4.05[B], at 4-26 (1993) (emphasis in original).

6. "The courts . . . interpreted Section 24 of the 1909 Act as meaning that the first term expired 28 years from publication or registration, whichever occurred first." 2 *Nimmer on Copyright*, § 9.01[C], at 9-19, n.92, *citing Marx v. United States*, 96 F.2d 204 (9th Cir. 1938); *Rose v. Bourne, Inc.*, 176 F. Supp. 605 (S.D.N.Y. 1959), *aff'd*, 279 F.2d 79 (2d Cir. 1960).

7. 17 U.S.C. § 13 (1909).

itself would commence the running of the 28-year term), but it *also* required the copyright proprietor to file a mandatory "Notice of Use" *as soon as the composition was released on phonorecord.*[8]

The purpose of the Notice of Use was to make the composition available for recording by third parties, who could thereafter obtain a "compulsory license" from the Copyright Office, without the composer's consent.[9] Thus, under the 1909 Copyright Act, exploitation of a musical composition through release on phonorecord was not merely a publication, it was also an immediate (but partial) dedication of the composition to the public domain in the sense that third parties were free to license it, even if the copyright proprietor objected.

This detailed statutory scheme is irreconcilable with the Petitioner's claim that the musical composition could be exploited by massive distribution on phonorecord without commencing the running of the 28-year copyright term. As noted above, on this point the District Court, the majority in the Ninth Circuit, and even the *concurring* opinion in the Ninth Circuit *all*

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8. 17 U.S.C. § 1(e) (1909) stated, in relevant part: "It shall be the duty of the copyright owner, if he . . . reproduce[s] mechanically the musical work, or licenses others to do so, to file notice thereof, accompanied by a recording fee, in the copyright office, and any failure to file such notice shall be a complete defense to any suit, action, or proceeding for any infringement of such copyright."

9. 17 U.S.C. § 1(e) (1909) stated, in relevant part: "[A]s a condition of extending the copyright control to such mechanical reproductions . . . whenever the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work . . . [in a mechanical reproduction], any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of 2 cents on each such part manufactured. . . ."

agreed. Moreover, contrary to the assertions of the Petitioner and the *amici*, there is *no* split of authority on this issue.

What is the basis for the Petitioner's assertion that there is a "split" among the Circuits on the "28-year term issue"? The Petition cites and relies on *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff'd per curiam*, 546 F.2d 461 (2d Cir. 1976) as its sole authority for this theory. The Petitioner and the *amici* claim that *Rosette* stands for the proposition that the failure to register a copyright released on phonorecord "tolled" the commencement of the 28-year term.

However, *Rosette* contains *no such holding*. In fact, United States District Court Judge Mariana Pfaelzer cited *Rosette* as authority *in favor* of a finding that release of a phonorecord commenced the running of the 28-year term. As stated in footnote 2 to the District Court's Memorandum of Decision:

> Although this Court adopts the majority rule that distribution of phonorecords constituted publication under the 1909 Act, *the Court's ruling that plaintiff's compositions entered the public domain, at the latest, in 1976 and 1978, is consistent with Rosette*. In *Rosette*, the court held that the distribution of phonorecords did not constitute "publication" so as to inject the recorded work into the public domain. 354 F.Supp. at 1193. The court nevertheless concluded that once phonorecords were distributed, the author could no longer assert common law rights against unauthorized recordings; but upon obtaining a statutory copyright and filing a notice of use, the author could sue under a statutory copyright theory. *Id.* The

> court's holding avoided immediate forfeiture of works distributed on phonorecord prior to 1978 without the statutory notice, but also avoided according greater rights under common law copyright than would be available if the author had first obtained statutory copyright by registering the composition as an unpublished work. 1 Nimmer on Copyright, § 4.05[B]. Here, if this Court were to accept plaintiff's argument that the statutory term of copyright began when the compositions were registered in 1967 and 1970, twenty years after they were distributed on phonorecord, plaintiff would receive greater rights than if plaintiff had registered the works immediately upon release of phonorecords. In effect, plaintiff would receive a perpetual copyright so long as it failed to comply with the requirements for obtaining statutory copyright.[10]

The majority opinion in the Ninth Circuit expressly adopted Judge Pfaelzer's holding that release of a phonorecord commenced the running of the 28-year term. Judge Fernandez (who dissented on the "divestment issue") *concurred* with the majority opinion on the running of the 28-year term, and stated:

> I think *Rosette* was quite logical, indeed correct. . . . ¶ Of course, *Rosette* did not directly speak to the length of protection under the 1909 Act. . . . But it seems to me that the reasoning process which drove *Rosette* supplies the answer to the length

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10. Memorandum of Decision at 8:15 (emphasis added).

> issue as well. That is, the author cannot recover the § 1(e) royalty beyond the time that an author could have recovered it had the author registered the work when he first released a recorded performance of it. Thus, the author who does not register in a timely fashion cannot artfully extend the time during which he can exploit his work. . . . ¶ For the reasons outlined by the majority, the difference between my approach and that of the majority makes no difference in the result regarding the recorded 1948 and 1950 versions of "Boogie Chillun."[11]

As Judge Fernandez noted, *Rosette* is consistent with the 28-year term holding in this case but did not *directly* address the running of the 28 year term. In fact, it appears that the *only* judicial opinions which speak directly to the issue of whether the release of a phonorecord commenced the running of the 28-year term under the 1909 Act are the three opinions written in *this* case. Judge Pfaelzer's Memorandum of Decision, the majority opinion of the Ninth Circuit written by Judge O'Scannlain, and the concurring opinion by Judge Fernandez *all* agree that release and sale of a phonorecord to the public commenced the running of the 28-year term. As noted above, the claim that there is a split with the Second Circuit on this issue is without merit; a careful reading of the Second Circuit cases discloses no such disagreement on this issue.[12]

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11. *La Cienega*, 53 F.3d at 955.

12. Petitioner and the *amici* argue that *Rosette* is the most authoritative and persuasive case on the "publication" issue. However, the Second Circuit based its *per curiam* affirmance on the *erroneous* logic that the issue would soon be moot as a result of the 1976 Copyright Act, and therefore was unworthy

(Cont'd)

In fact, for Constitutional reasons, U. S. District Court Judge Gurfein expressly limited the scope of his holding in *Rosette* so that it did not conflict with the "Sears-Compco Doctrine."[13] To avoid the unintended creation of "perpetual common law copyrights" Judge Gurfein added the following *caveat* to his opinion:

> To avoid the constitutional problem I think that the exception . . . must be limited to exclude the sale of phonograph records from the protection given to the owner of an unpublished manuscript to the extent that the common law right exceeds the rights of the statutory copyright owners. The conditions for use of the musical composition on phonograph records are so well defined in the comprehensive Copyright Act of 1909 that it is unlikely that the Congress intended that contradictory principles of State law should survive.[14]

As noted above, had Petitioner promptly registered the

(cont'd)
of a more careful consideration by the Court. *Rosette*, 546 F.2d at 462, n.1 As demonstrated by the alarmist rhetoric in the brief of the *amici*, the issue is far from "moot." Moreover, *Jones v. Virgin Records, Ltd.*, 643 F. Supp. 1153 (S.D.N.Y. 1986), one of the few cases to follow *Rosette*, did so only reluctantly, stating: "[W]e are aware that *Rosette* is not without its critics and is not followed by a majority of district courts in other circuits. . . ."

13. *Sears, Roebuck & Co. v. Stiffel Company*, 376 U.S. 225, 84 S. Ct. 784 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 84 S. Ct. 779 (1964).

14. *Rosette*, 354 F. Supp. at 1193.

copyrights and promptly filed Notices of Use at the time the "Boogie Chillen" phonorecords were released — as required by the 1909 Copyright Act — then there would be no dispute that the 28-year terms expired in 1976 and 1978. Petitioner's theory is that, by *violating* the registration and notice of use obligations under the 1909 Act, he tolled the running of the 28-year term. Since there is no authority for this proposition, and no reason for this Court to even consider it, certiorari should be denied.

II.

THE NINTH CIRCUIT FOLLOWED AND CORRECTLY APPLIED *STEWART V. ABEND* AND ENFORCED THE RENEWAL RIGHTS OF COMPOSERS AND THEIR HEIRS.

By asking this Court to *toll* the running of the 28-year term, Petitioner and the *amici* are also asking the Court to delay or frustrate the renewal rights which Congress granted to composers and their heirs under the 1909 Act. Therefore, such a holding would be in conflict with this Court's rulings in *Stewart v. Abend*, 495 U.S. 207, 110 S. Ct. 1750 (1990) and *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 80 S. Ct. 792 (1960).

Under § 24 of the 1909 Copyright Act, the renewal right belonged to the original composer (or the composer's heirs), and could only be secured by registering the renewal with the Copyright Office during the final year of the initial 28-year term. 17 U.S.C. § 24 (1909); *Tobani v. Carl Fischer, Inc.*, 98 F.2d 57 (2d Cir. 1938); 2 *Nimmer on Copyright*, § 9.05[B], at 9-64 ("The 1909 Act provided that following expiration of the initial 28-year term, *specified claimants* were entitled to ownership of the renewal 28-year term.") (emphasis added).

The *amici* and the Petitioner would frustrate and delay the exercise of the composer's renewal rights by tolling the initial 28-year term for the benefit of the music publishers, at the expense of the composer. By way of example, under the Ninth Circuit's holding in *La Cienega*, a composition released on phonorecord 28 years ago (1967) would just now be eligible for renewal by the composer or the composer's heirs, whether it was registered in 1967 or not, and irrespective of whether the publisher recorded a Notice of Use. However, if the legal doctrine proposed by the *amici* were to be adopted by this Court, the music publisher's failure to register the copyright in 1967 would toll the running of the 28-year-term indefinitely. This would obviously favor the large, institutional grantees and licensees, over the interests of the composers and their survivors.

There is *no authority whatsoever* for this proposed tolling of the 28-year term. Because of the absence of authority, the Petitioner and the *amici* propose a strained re-interpretation of *Rosette*, and make unsupported, alarmist arguments about the alleged impact on the music industry if the "28 year term" aspect of the *La Cienega* ruling is not reversed.

However, in making these arguments, the *amici* attempt to gloss over the adverse impact that overturning the Ninth Circuit's "28-year term issue" ruling would have on the renewal and termination rights of 1960s and 1970s-era composers and their heirs.

The Supreme Court should reaffirm the Ninth Circuit's ruling that the 28-year term commences with release and sale of a phonorecord to the public. That would reinforce the composers' renewal rights with respect to compositions released on phonorecord in the late 1960s and 1970s. As this Court stated in *Stewart*, 495 U.S. at 229, 110 S. Ct. at 1764:

> When an author produces a work which later commands a higher price in the market . . . the copyright statute is designed to provide the author the power to negotiate for the realized value of the work. That is how the separate renewal term was intended to operate. . . . At heart, petitioner's true complaint is that they will have to pay more for the use of works they have employed in creating their own works. But such a result was contemplated by Congress and is consistent with the goals of the Copyright Act.

See also, Abend v. M.C.A., Inc., 863 F.2d 1465, 1477 (9th Cir. 1988) ("[B]y enacting section 24 [of the 1909 Act], Congress intended to provide protection to the author's family and so extended the renewal right to include the author's surviving family or heirs, should the author die during the original term of the copyright.").

III.

THE CONGRESSIONAL INTENT UNDER THE 1909 COPYRIGHT ACT WAS THAT THE 28-YEAR TERM COMMENCED UPON THE SALE OF PHONO-RECORDINGS TO THE PUBLIC.

The Petitioner and the *amici* assert that the Ninth Circuit is in conflict with *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1, 28 S. Ct. 319 (1908), wherein the Supreme Court held that a player piano roll was not an infringement because it was merely a "performance" of the work, not a "copy". However, Congress expressly overruled *White-Smith* when it enacted the 1909 Copyright Act. Indeed, in his concurrence in *White-Smith*, Justice Oliver Wendell Holmes directly *advocated* such congressional action:

> A musical composition is a rational collocation of sounds apart from concepts, reduced to a tangible expression from which the collocation can be reproduced either with or without continuous human intervention. *On principle anything that mechanically reproduces that collocation of sounds ought to be held a copy, or, if the statute is too narrow, ought to be made so by a further act. . . .*[15]

As noted, Congress took up Justice Holmes' suggestion at the very next session, when it passed the 1909 Copyright Act, expressly extending the composer's copyrights to include mechanical reproductions, and at the same time creating the "compulsory license" and notice of use provisions. This enactment clearly eliminated both the doctrinal and the statutory bases for *White-Smith*.

The Legislative History of the 1909 Act memorializes the Congressional concern that a monopoly might develop if musical compositions released on phonorecord were not available for exploitation by competitors. The House Report on the Copyright Act of 1909 (excerpted in Appendix F-1 to the Petition for Certiorari), states, in relevant part:

> Your committee have felt that justice and fair dealing [required that] . . . the composer should have the . . . right of forbidding, if he so desired, the rendition of his copyrighted music by the mechanical reproducers. How to protect him in these rights without

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15. *White-Smith*, 209 U.S. at 19-20, 28 S. Ct. at 324 (Justice Holmes, concurring) (emphasis added).

> establishing a great music monopoly was the practical question which the committee had to deal with. The only way to effect both purposes, as it seemed to the committee, was, after giving the composer the exclusive right to prohibit the use of his music by the mechanical reproducers, to provide that if he used or permitted the use of his music for such purpose, then, upon the payment of a reasonable royalty, all who desired might reproduce the music.

When Congress enacted this detailed, pro-competitive statutory scheme, it clearly did not intend to allow music publishers to *evade* the compulsory license through non-compliance with the registration and Notice of Use obligations. Historians record that some music publishers attempted to avoid the compulsory license by deliberately *not* registering and *not* filing a Notice of Use. As stated in 1 *Nimmer on Copyright*, § 4.05[B][4], at 4-32:

> [T]here was some reluctance to secure statutory copyright in such musical compositions even as a precautionary measure against the increasing number of decisions holding sale of phonorecords to be a publication. This apparent absence of prudence was in some part due to a desire to avoid subjecting the recorded composition to the compulsory license provision of Section 1(e) of the 1909 Act, in an attempt to exploit a medium regulated by statute without submitting to that regulation.

IV.

CONGRESS INTENDED THAT A FAILURE TO REGISTER FOR THE RENEWAL TERM DEDICATED A WORK TO THE PUBLIC DOMAIN.

There can be no dispute that it was Congress' intent that failure to renew a copyright would cause it to expire and lapse into the public domain. 17 U.S.C. § 24 (1909). In 1976, Congress contemplated abolition of the renewal registration requirement, but ultimately decided to *keep* this provision of the former statute. The House Report on the Copyright Act of 1976, in explaining § 304, stated:

> Subsection (a) of section 304 reenacts and preserves the renewal provision, now in section 24 of the statute, for all of the works presently in their first 28-year term. . . . *Renewal registration will [still] be required during the 28th year of the copyright but the length of the renewal terms will be increased from 28 to 47 years.*[16]

The fact that Congress required registration as a prerequisite to the renewal of a copyright is irreconcilable with Petitioner's claim that Petitioner could extend his initial 28-year term by *not* registering in the first place. There is no authority whatsoever for Petitioner's legal theory, nor is there any split in the Circuits which would justify consideration of this issue by the Supreme Court. Even the dissenter in the Ninth Circuit *concurred* in the "28-year term" ruling by the majority, and there is not one single judicial decision which has held otherwise. Therefore, on the "28-year term" issue, the Petition should be *denied*.

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16. H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. at 139 (1976) (emphasis added).

V.

THE CONSTITUTIONAL LIMIT ON THE DURATION OF COPYRIGHTS IS IRRECONCILABLE WITH PETITIONER'S ATTEMPT TO CREATE A "PERPETUAL COMMON LAW COPYRIGHT."

Another Constitutional ground for rejecting Petitioner's "tolling-by-failure-to-register" theory is the Copyright Clause of the United States Constitution, which expressly instructs Congress to restrict the duration of copyright monopolies to a "limited Time." U.S. Const., Art. I, § 8. This Constitutional issue was discussed in *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 89 (2d Cir. 1940), wherein Judge Learned Hand wrote:

> [W]hen the "common law property" is in a work which the Copyright Act . . . covers, there can be no doubt; *Congress has created the [Copyright] monopoly in exchange for a dedication, and when the monopoly expires the dedication must be complete*. . . . It is . . . argued [by the Plaintiff] that . . . there is a perpetual common law copyright in works not copyrightable under the act; we have answered that argument. . . . [W]e see no reason why the same acts that unconditionally dedicate the common-law copyright in works copyrightable under the act, should not do the same in the case of works not copyrightable. Otherwise it would be possible . . . to have the advantage of dissemination of the work at large, and to retain a perpetual, though partial, monopoly in it. That is contrary to the whole policy of the Copyright Act and of the Constitution.

(Emphasis added).

Judge Hand's analysis is pertinent to the present matter, since the Petitioner is claiming that his failure to register "Boogie Chillen" for almost 20 years after release of the phonorecord had the legal consequence of *extending* the 28-year statutory copyright period. Under the Plaintiffs' theory, the "common law" copyright would have gone on *forever* — so long as Petitioner continued to violate the deposit/registration/notice-of-use provisions of the 1909 Copyright Act.

The rule which Petitioner proposes is precisely the kind of "perpetual common law copyright" that Judge Hand — and the framers of the Constitution — rejected. Nothing in *Rosette* (nor any other case) states a contrary view. Indeed, as noted hereinabove, *Rosette* was even cited by Judge Pfaelzer as persuasive authority for *rejecting* Petitioner's theory.

The 28-year term was Congress' application of the Constitutional mandate to grant a copyright monopoly only for a "limited Time." Had "Boogie Chillen" been "promptly" registered with the Copyright Office at the time it was released, and a Notice of Use filed — as the law *required* — there would be no dispute that the 28-year term expired. Any effort to *extend* the monopoly, by *disobeying* the Copyright Act would run afoul not just of the "majority" view, and the "Sears-Compco doctrine," but also the "limited Time" restriction in the Copyright Clause of the United States Constitution.

VI.

THE PETITIONER AND THE *AMICI* SEEK TO MISLEAD THIS COURT AND DISTRACT THE COURT'S ATTENTION BY PROFFERING ELABORATE ARGUMENTS ABOUT THE NON-EXISTENT "PRIOR REGISTRATION" ISSUE.

The Petition for Writ of Certiorari criticizes the Ninth Circuit for holding that the release of a phonorecord *prior to copyright registration* injects the composition into the public domain.[17] A similar attack on this supposed ruling is vigorously pursued by the *amici*, who raise alarmist arguments about the supposedly dire consequences for the music industry if the "prior registration" ruling is not reversed. Indeed, counsel for the Petitioner and the *amici* were so concerned about this purported "ruling," they jointly mounted a publicity campaign, and issued a press release criticizing the Ninth Circuit for it.

The problem with the rhetoric of the Petitioner and the *amici* is, *the Ninth Circuit made no such ruling*. Nor could such a holding even be implied in the Ninth Circuit's decision, because the remand of the "Canned Heat" version to the District Court is at odds with such an interpretation. Specifically, the Ninth Circuit recites in its opinion that the "Canned Heat" version of "Boogie Chillen" was released on phonorecord in 1970, but it was not registered with the Copyright Office until 1992. *LaCienega*, 53 F.3d at 952. The Court of Appeals then reversed the District Court's ruling that this composition is in the public domain, and remanded to the District Court for a determination whether the 1970 "Canned Heat" phonorecord had a copyright notice on it. *Id.* at 954.

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17. Petition for Writ of Certiorari, Issue No. 2(a).

There could not have been such a remand, if the Ninth Circuit had ruled as the Petitioner describes, because the "Canned Heat" version was not registered until *22 years* after the phonorecord was released. In fact, the Ninth Circuit remanded because its ruling is based on the absence of any factual determination of whether there was a copyright notice on the 1970 phonorecord — not on the timing of registration with the Copyright Office. Since the Ninth Circuit did not rule as the Petitioner contends, this Court is not presented with a "case or controversy" to review, and certiorari on the "prior registration" issue should be *denied*.

Respectfully submitted,

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